

REMARKS

By this Amendment, Applicant amends claims 1, 8, and 14-16, and cancels claims 17, 18, and 20-23, without prejudice or disclaimer to the subject matter thereof. Claims 1, 3-8, 10, 11, and 14-16, and 19 remain pending.

In the Office Action, the Examiner rejected claims 1, 3, 4, 6-8, 10, 14, and 16-18 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,112,084 to Sicher ("Sicher") in view of United Kingdom Patent No. 2311910A to Robinson et al. ("Robinson"); rejected claims 5, 11, and 15 under 35 U.S.C. § 103(a) as unpatentable over Sicher and Robinson in view of U.S. Patent No. 6,704,813 to Smirnov et al. ("Smirnov"); rejected claims 17, 19-21, and 23 under 35 U.S.C. § 103(a) as unpatentable over Sicher and Robinson in view of JP-11146370 to Uehara ("Uehara"); rejected claim 22 under 35 U.S.C. § 103(a) as unpatentable over Sicher and Robinson in view of Smirnov and Uehara; and rejected claim 18 under 35 U.S.C. § 103(a) as unpatentable over Sicher and Robinson in view of Uehara and further in view of U.S. Patent No. 5,159,445 to Gitlin ("Gitlin").¹ Applicant respectfully traverses the Examiner's rejections under § 103(a).

Applicant respectfully traverses the Examiner's rejection of claims 1, 3, 4, 6-8, 10, 14, and 16-18 under 35 U.S.C. § 103(a) as unpatentable over Sicher in view of Robinson, because a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, the prior art reference (or references when

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Independent claim 1, as amended, recites a combination including, for example, “wherein the informing means includes a first display section which displays a picture concerning the first communication entity received by the first communication means and a picture concerning an operator at the terminal transmitted by the first communication means, and a second display section which displays a message from the second communication entity received by the second communication means while the communications are made by the first communication means.”

Sicher and Robinson fail to teach or suggest at least these features of amended claim 1. The Examiner concedes that “they [Sicher and Robinson] fail to disclose a method wherein the informing means includes a first display section which displays a picture concerning the first communication entity received by the first communication means, and a second display section which displays a picture concerning an operator at the terminal transmitted by the first communication means.” (Office Action at 6.)

However, the Examiner alleges that “Uehara . . . teaches a portable video telephone system. He further discloses a method wherein the informing means includes a first display section which displays a picture concerning the first communication entity received by the first communication means, and a second display section which displays a picture concerning an operator at the terminal transmitted by

the first communication means. See abstract and Fig. 1.” (Office Action at 6.)

Applicant respectfully disagrees.

Uehara teaches that “a display section 29 is divided into two, an image sent from an opposite party is displayed on a right side display section 29b. An image received from a removable image photographing adaptor is displayed on a left side display section 29a.” Uehara, abstract. However, a mere division of display into two image display section does not constitute either “a first display section which displays a picture concerning the first communication entity received by the first communication means and a picture concerning an operator at the terminal transmitted by the first communication means,” or “a second display section which displays a message from the second communication entity received by the second communication means while the communications are made by the first communication means,” as recited in amended claim 1 (emphasis added).

The Examiner also alleges that “Gitlin . . . teaches a method of displaying video images along with text images during video teleconferencing. See col. 1, lines 14-24.” (Office Action at 8.) Applicant also disagrees with the Examiner on this point. In the paragraph cited by the Examiner, Gitlin explicitly states that “[d]igital images such as text and graphics are displayed on each conferees display terminal while video images of the conferees are also displayed in a portion of the display.” Gitlin, column 1, lines 19-22.

However, Gitlin's teaching of merely display digital images and video images on the same display does not constitute either “a first display section which displays a picture concerning the first communication entity received by the first communication

means and a picture concerning an operator at the terminal transmitted by the first communication means,” or “a second display section which displays a message from the second communication entity received by the second communication means while the communications are made by the first communication means,” as recited in amended claim 1 (emphasis added). In fact, Gitlin is silent on any communication means.

Further, Gitlin's mentioning of displaying digital images and video images in column 1, lines 14-24 is listed as a disadvantage to be overcome by the disclosed invention. Thus, Gitlin actually teaches away from the teaching alleged by the Examiner.

Therefore, none of Sicher, Robinson, Uehara, and Gitlin, taken alone or in any reasonable combination, teaches or suggests all elements of amended claim 1. A *prima facie* case of obviousness cannot be established. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 1. Because claims 3 and 4 depend from claim 1, Applicant also requests withdrawal of the Section 103(a) rejection of claims 3 and 4 for at least the same reasons stated above.

Amended independent claims 8, 14, and 16, while of different scope, include recitations similar to that of amended claim 1. Claims 8, 14, and 16 are therefore also allowable over Sicher, Robinson, Uehara, and Gitlin for at least the same reasons stated above with respect to amended claim 1. Applicant respectfully requests withdrawal of the Section 103(a) rejection of claims 8, 14, and 16, and of dependent claim 10, which depends from claim 8.

Independent claim 6 recites a combination including, for example, “input means used in common at the time of simultaneous communications over the first and second radio channels, wherein the input means includes means for selecting one of the established first and second radio channels and means for inputting information to make communications over the selected radio channel.” Sicher fails to teach or suggest at least these features of claim 6.

The Examiner concedes that “Sicher does not specifically disclose input means for selecting one of the established first and second radio channels and means for inputting information to make communication over the selected channel.” (Office Action at 4.) However, the Examiner alleges that “Robinson . . . teaches an input means for selecting one of the established first and second radio channels and means for inputting information to make communication over the selected channel. See Fig. 3 and page 5, lines 21-27.” (Office Action at 4.) Applicant respectfully disagrees.

In Fig. 3 and page 5, Robinson explicitly states that “[i]f the second user interface 115 is detached from the portable radio communication unit 103, then the received data is output over the bus 119 to the first user interface 113. If the second user interface 115 is coupled to the radio communication unit 103 via databus 121, then the received information is output via the bus 121 to the second user interface 115.” Robinson, page 5, lines 12-21. However, Robinson’s teaching of using separate user interfaces 113 and 115 does not constitute “input means used in common at the time of simultaneous communications over the first and second radio channels,” as recited in claim 6 (emphasis added). Further, Robinson does not disclose “the input means includes means for selecting one of the established first and second radio channels and means

for inputting information to make communications over the selected radio channel,” as recited in claim 6 (emphasis added).

Therefore, neither Sicher nor Robinson, taken alone or in any reasonable combination, teaches or suggests all elements of claim 6. A *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 6 and its dependent claim 7.

Applicant respectfully traverses the Examiner’s rejection of claims 5, 11, and 15 under 35 U.S.C. § 103(a) as unpatentable over Sicher and Robinson in view of Smirnov. Claims 5 and 11 depend from claim 1 and 8, respectively.

As set forth above, Sicher and Robinson fail to teach or suggest at least “a first display section which displays a picture concerning the first communication entity received by the first communication means and a picture concerning an operator at the terminal transmitted by the first communication means, and a second display section which displays a message from the second communication entity received by the second communication means while the communications are made by the first communication means,” as recited in claims 1, 8, and 15 and required by claims 5 and 11.

The Examiner alleges that “Smirnov . . . teaches the use of a radio communication terminal further comprising storage means for storing information utilized when radio communications are made” (Office Action at 5.) Even assuming the Examiner’s allegations are true, which Applicant does not concede, Smirnov fails to cure the deficiencies of Sicher and Robinson as to the claimed “a first display section which displays a picture concerning the first communication entity

received by the first communication means and a picture concerning an operator at the terminal transmitted by the first communication means,” or “a second display section which displays a message from the second communication entity received by the second communication means while the communications are made by the first communication means,” as recited in amended claims 1, 8, and 15 and required by claims 5 and 11 (emphasis added).

Therefore, Sicher, Robinson, and Smirnov fail to teach or suggest all elements required by claims 5, 11, and 15. Claims 5, 11, and 15 are thus allowable over Sicher, Robinson, and Smirnov. Applicant respectfully requests withdrawal of the Section 103(a) rejection of claims 5, 11, and 15.

Applicant respectfully traverses the Examiner’s rejection of claims 17, 19-21, and 23 under 35 U.S.C. § 103(a) as unpatentable over Sicher and Robinson in view of Uehara. Because claims 17, 20, and 21 have been canceled, the Section 103(a) rejection of claims 17, 20, and 21 is moot. Claim 19 depends from claim 6.

As set forth above, Sicher and Robinson fail to teach or suggest at least “input means used in common at the time of simultaneous communications over the first and second radio channels, wherein the input means includes means for selecting one of the established first and second radio channels and means for inputting information to make communications over the selected radio channel,” as recited in claim 6 (emphasis added). Uehara fails to cure the deficiencies of Sicher and Robinson.

Uehara teaches that “a display section 29 is divided into two, an image sent from an opposite party is displayed on a right side display section 29b. An image received from a removable image photographing adaptor is displayed on a left side display

section 29a.” Uehara, abstract. However, Uehara fails to teach or suggest the above listed features as recited in claim 6 and required by claim 19.

Therefore, Sicher, Robinson, and Uehara fail to teach or suggest all elements required by claim 19. Claim 19 is therefore allowable over Sicher, Robinson, and Uehara. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 19.

Applicant respectfully traverses the Examiner’s rejection of claim 22 under 35 U.S.C. § 103(a) as unpatentable over Sicher and Robinson in view of Smirnov and Uehara. Because claim 22 has been canceled, the Section 103(a) rejection of claim 22 is moot.

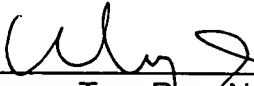
Applicant respectfully traverses the Examiner’s rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over Sicher and Robinson in view of Uehara and further in view of Gitlin. Because claim 18 has been canceled, the Section 103(a) rejection of claim 18 is moot.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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